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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,007	02/08/2005	Stefan Koller	C000022735	9480

324 7590 08/30/2010

BASF Corporation
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EXAMINER

HOLLOMAN, NANNETTE

ART UNIT	PAPER NUMBER
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1612

NOTIFICATION DATE	DELIVERY MODE
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08/30/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/524,007</p>	<p>Applicant(s) KOLLER ET AL.</p>	
	<p>Examiner NANNETTE HOLLOMAN</p>	<p>Art Unit 1612</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): the indefiniteness rejection under 35 USC 112, second paragraph.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 8.
Claim(s) rejected: 1,3-6 and 11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612

/NANNETTE HOLLOMAN/
Examiner, Art Unit 1612

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1, 3-6, 8 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Struillou et al. (EP 0752465) in view of Hirota et al. (JP2002220380, English Translation). This rejection is maintained.

Applicant argues a hydroxyl group cannot in any sense be considered the same as a carboxylic acid group and the acid functionality of the carboxylic acid group of the amino acid is not reacted with a halogen-substituted aliphatic carboxylic acid halide yielding a halogen-substituted ester as presently claimed. Applicant further argues the diamine of Hirota has an entirely different function/purpose from the amines taught in Struillou. Applicant also argues there would have been no expectation of success or that the combination would result in a predictable result based on the combination of the references.

Examiner response: In regard to the hydroxyl group, it is known that a carboxylic acid group contains a carbon atom joined to oxygen by a double bond and a hydroxyl group, therefore encompassing the limitation of "biologically active hydroxyl group containing substance". At paragraph [0079], Hirota discloses an example in which the reagents used in the reaction are a biologically active hydroxy group; an aliphatic carboxylic acid halide and a diamine containing at least one tertiary amino group, encompassing the reagents of instant claim 1. In said reaction of Hirota, the process is performed in one vessel comprising the above reagents; wherein the final product is an ester. Therefore, it can not be concluded that the intermediate compound allegedly produced by Hirota, as proposed by Applicant, is the only possible compound formed from the reactions within said vessel. Applicant's claims do not recite the actual mechanistic steps of the reaction or that certain intermediates are or are not formed to arrive at the final product of the ester; therefore the references do not have to disclose the mechanistic steps to the final product, i.e. an ester. Therefore, because the disclosure of Hirota, which teaches 1,2-bis(dimethylamine)ethane as an amine compound used in a reaction with a carboxylic acid halide compound and a biologically active hydroxyl group containing substance, have the same reaction steps as Struillou to form an ester, one of ordinary skill would have a reasonable expectation of success when using said amine compound in the method of Struillou. Furthermore, as previously asserted, it is prima facie obviousness to select a known material based on its suitability for its intended use. Also, established precedent holds that it is generally obvious to add known ingredients to known compositions with the expectation of obtaining their known function. MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art to have used the 1,2-bis(dimethylamine)ethane as the amine of Struillou since it is taught that similar amine compounds may be used in reactions to form esters.